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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,087	01/29/2002	Haruko Toyoshima	0445-0315P	2505
2292	7590	03/23/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			REICHLER, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	
DATE MAILED: 03/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,087

Applicant(s)

TOYOSHIMA, HARUKO

Examiner

Karin M. Reichle

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Applicants have added several limitations to claims 1 and 4, see underlined portions thereof. In the remarks certain portions of the original specification were referred to as providing support therefor. The limitations added at lines 7, 12-13 and the last two lines of claim 1 are clear and supported by the cited portions. With regard to the remaining additions, at the very least, it is unclear what structure is being described. For example, on lines 10-11 Applicant now sets forth that the under-waist elastic members are different from the continuous waist elastic member. None of the portions cited by Applicants refer to such difference. Therefore, how are they different? Is this the same as the addition to 14-15, i.e. they are not monolithically formed but separate members? Note Applicants' arguments bridging pages 11-12. Or is this difference that described at page 9, lines 17-26? Further with regard to lines 14-15, how don't the members not overlap? Is Applicant claiming that the members don't physically touch, which is shown, or something else? The waist member not extending in the waist opening portion which is above the portion of the under-waist portion having the under-waist elastic elements? What is being claimed in the last 5 lines of page 2? Note the sentence bridging pages 7-8 of the specification. In view of this description the first and second and fourth and fifth lines from the bottom would be interpreted as reciting elastic members being fixed in the claimed areas to manifest contractibility. However, such interpretation is now unclear due Applicant's discussion bridging pages 10-11 of the remarks which is not consistent therewith. Furthermore, the lack of clarity is

Art Unit: 3761

exacerbated by the description added by the second through the fourth lines. What plane? Is Applicant trying to describe the expanded state of the diaper or something else? Part of the process by which the elastic members are being disposed, i.e. a stretch bonded laminate of some sort? On the fourth to last line, a waist opening portion is described as having fastening tapes. Is Applicant now describing the waist opening portion also having tapes directly thereon which is not shown or something else? Indirectly having tapes? If the latter, then it is noted that all portions of the diaper not directly having the tapes indirectly have the tapes. See also discussion of claim 4 infra. Therefore, a clear description of the invention supported by the originally filed specification should be set forth. If Applicant maintains the discussed additions, reference to the portion of the original specification which provides a clear description of each individual addition in a single embodiment should be set forth.

Appropriate correction is required.

Claim Objections

2. Claims 1-4 are objected to because of the following informalities: in claim 1, line 18, "an upright" should be --one of the--. This also applies to similar language, "the upright" on the second to last line of claim 1. On line 12 of claim 1, "respectively" should be deleted as it is now redundant. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, a clear antecedent basis for “said waist opening portion having said fastening tapes” (fourth line from the bottom) should be set forth. A positive structural antecedent basis for “the plane” (line 19) should be set forth. In claim 4 a positive structural antecedent basis for “said pair of leg elastic members” and “respective ends...in said portion having said pair of fastening tapes” should be set forth. Also it is unclear which “said portion having said fastening tapes” is being referred to, i.e. the under waist-portion? the waist opening portion? the portion of the diaper on line 6 of claim 1?

4. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See discussion in the previous paragraph with respect to claim 4. Claim 4, as best understood, describes leg elastic members, i.e. those of the upright cuffs, being curved in a certain manner and located in a certain manner with respect to the under-waist elastic members. While the originally filed specification provided support for the elastic members 9 having such structure, the elastic members being defined are those of the cuff, i.e. 61 not 9. Where does the originally filed specification provide support for such features of the elastic members of the cuffs? If

Art Unit: 3761

Applicant maintains such claim language the portion of the original specification relied upon should be set forth.

Claim Language Interpretation

5. Claim 1 as best understood still does not require the members be stretched from a nonstretched state to a stretched state and then fixed to the areas in the stretched state and then released from such state allowing contraction to the nonstretched state. The fixing of a temporarily or permanently stretched material to the areas and the areas being able to contract due to the disposition of such stretched material only is required. It is further noted that the claims, as best understood, still do not require the under-waist portion positioned right below the waist opening portion and the areas extending outwardly from the absorbent be one and the same, i.e. coextensive, or the under-waist elastic members only being in the under-waist portion or being coextensive therewith. Finally it is noted that while the waist opening portion requires a continuous waist elastic member, such member is still not required to be continuous with the entire waist portion, i.e. the member is continuous in some portion of the waist opening portion (Note the original filed Figures show a continuous elastic member in each of the front and rear portions of the waist opening portion, but such member does not span the entire front or rear portion, i.e. does not extend side edge to side edge in such portions). Nor is the elastic member required to be provided in the portion of the waist opening portion which is right above the under waist portion or right above the elastic members thereof. These comments also apply to similar language in claims 5-8. (It is noted that the language of claim 1, i.e. "being positioned right below", and that of claim 5, i.e. "positioned directly below" appear to be the same as "right" as

Art Unit: 3761

defined by the dictionary is “in direct line or course directly, straight” and “direct” is defined as “to extend or project in a specified line or course”.) All the claims now require the fastening tapes be directly attached to the under-waist portion. However this does not require that the tapes are directly attached to the elastic members thereof. Nor do the claims 1-8 as best understood require the entire waist opening portion have an extension stress less than that or those of the entire under-waist portion. In addition, due to the lack of clarity discussed supra, claim 1 will be interpreted as requiring at a minimum non-monolithically formed waist opening and under-waist elastic members in light of the additions to lines 10-11 and 14-15, elastic members in the areas outside the absorbent member but not the middle area which are fixed in such areas so as to manifest contractibility in light of the additions to the last five lines on page 2, and the under-waist portion having a greater extension stress than at least some portion of the waist opening portion which is at least indirectly connected to the tapes in light of the additions to the fourth to last line. With respect to claim 4, see MPEP 2163.06 (I).

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Clear et al '584, and thereby Buell et al '274.

See Figure 2, i.e. topsheet 24, backsheet 22, core 28, fastening tapes 92, landing zone 44, waist opening portion is at least a portion of waist edge 64, waist elastic member 34, under-waist portion is at least a portion of 30 which portion includes at least a portion of elastic members 90

Art Unit: 3761

and which portion is additionally directly attached to at least a portion of tape 92. See also col. 14, lines 27-61, col. 15, line 16-col. 16, line 24 of Clear et al, and thus by incorporation Buell '274 at, e.g., col. 35, line 57-col. 36, line 30, especially col. 36, lines 2-5, i.e. the members 90 can be associated with the topsheet and backsheet in the tensioned condition, i.e. stretched state, col. 51, lines 3-64, esp. lines 56-64, Figure 1, col. 45, lines 23-30, col. 15, lines 16-27, col. 23, lines 13 et seq, col. 33, lines 51-53, col. 42, lines 44-52, col. 43, lines 14-38. It is also noted that 1N is about 150 gf. With regard to the limitations added to claim 1 not already addressed supra, see Claim Language Interpretation section supra, the discussion of references supra and the discussion infra with respect to the remarks, i.e. '584 and '274 include at a minimum non-monolithically formed waist opening and under-waist elastic members, i.e. elements 34 and 90 and also note col. 42, lines 44-42 of '274 again as well as col. 46, lines 13-31 of '274, elastic members of the under-waist portion in the areas outside the absorbent member but not the middle area which are fixed in such areas so as to manifest contractibility, see portions of references cited supra, and the under-waist portion having a greater extension stress than at least some portion of the waist opening portion which is at least indirectly connected to the tapes, see portions of references cited supra.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3761

9. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Clear et al '582, and thereby Buell et al '274 and Lawson '278.

With regard to claim 4, see the paragraph bridging cols. 13-14 of '584, and thereby by incorporation, '278 at, e.g., the Figures, especially Figure 3 and Figure 7, and col. 11, lines 45-51, and the Figures of '582, especially element 85 and 86. Therefore '582 is considered to teach or obviously teach the elastics disposed along an inwardly curved line, as best understood, because when the cuff elastics shown in the stretched state are allowed to contract, the diaper forms U-shape and the elastics are disposed along such U-shape which is an inwardly curved line and teach the location of the elastic members, as best understood, because an elastic member 77 as taught '278 can be situated adjacent the attached end of the upstanding portion of the cuff, i.e. the edge of 85 laterally outwardly of 86 as shown by '584, whereby the ends thereof are disposed further outward relative to the middle of the width direction than the inwardmost lateral edge of 90.

Response to Arguments

10. Applicant's remarks on pages 6-22 have been noted. Specifically, Applicant's request for an interview is noted. However in light of the new grounds of rejection and other new issues, such request is held in abeyance until review of this action by the Applicant. Furthermore, in order to more readily identify such a request in a timely manner, Applicant is requested to personally contact the Examiner with any further requests for an interview. Applicants other remarks on pages 6-8 have been considered, see especially discussion in

Art Unit: 3761

paragraphs 1-5 supra. The remarks with respect to the prior art on page 8-22 have been considered but since they are substantially the same as those set forth on pages 8 et seq of the 4-29-05 response such remarks are still considered not persuasive for the same reasons as set forth in paragraph 5 of the last Office Action, especially in light of the new issues set forth in paragraphs 1, 3 and 4 supra.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any new grounds of rejection were necessitated by the amendments to claims 1 and 4.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

Art Unit: 3761

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
March 17, 2006